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PRODUCTIONS CO. LTD.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

WESTERN DIVISION

UM CORPORATION, a Japanese
corporation,

Plaintiff,

vs.

TSUBURAYA PRODUCTIONS CO.
LTD., a Japanese corporation,

Defendant.

CASE NO. 2:15-cv-03764-AB-AJW

**DEFENDANT AND
COUNTERCLAIMANT
TSUBURAYA PRODUCTIONS CO.
LTD.'S RESPONSE TO JANUARY
19, 2016 ORDER TO SHOW CAUSE**

(Declarations of Daniel C. Posner,
Russell Ortiz and Chris Reynolds filed
concurrently herewith)

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TSUBURAYA PRODUCTIONS CO.
LTD., a Japanese corporation,

Counterclaimant,

vs.

UM CORPORATION, a Japanese
corporation; ULTRAMAN USA, INC.,
a California corporation; SOMPOTE
SAENGDUENCHAI, a Thai individual;
GOLDEN MEDIA GROUP, INC., a
California corporation; TIGA
ENTERTAINMENT COMPANY,
LTD., a Hong Kong corporation; and
DOES 1-10,

Counterdefendants.

Judge: Hon. André Birotte, Jr.

Trial Date: April 18, 2017

Tsuburaya's Response to Order to Show Cause

Defendant and Counterclaimant Tsuburaya Productions Co. Ltd. ("Tsuburaya") hereby responds to the Court's January 19, 2016 Order to Show Cause Regarding Dismissal for Lack of Prosecution, Dkt. 51 ("OSC"). The OSC requires Tsuburaya to show cause why its Counterclaims (Dkt. 19) should not be dismissed against counter-defendants TIGA Entertainment Company, Ltd. ("TIGA") and Sompote Saengduenchai ("Sompote"). For the reasons set forth below, good cause exists to discharge the OSC as to both TIGA and Sompote.

1. The OSC Should be Discharged as to TIGA Because TIGA has been Served with the Summons and Counterclaims.

First, Tsuburaya respectfully requests that the Court discharge the OSC as to TIGA. In Tsuburaya's Counterclaims, TIGA is alleged to have licensed, sold and distributed various "Ultraman" works in violation of Tsuburaya's copyrights in those works. (Dkt. 19 at 22.) TIGA is further alleged to be a corporation organized under the laws of, and with a principal place of business in, Hong Kong. (*Id.* at 13.)

Federal Rule of Civil Procedure 4(m), cited in the OSC and relating to time-limits for service, "does not apply to service in a foreign country." Fed. R. Civ. P. 4(m). Accordingly, the time-limits for service set forth in Rule 4(m) do not apply to Tsuburaya's service of the Summons (Dkt. 26) and Counterclaims on TIGA.

Nevertheless, Tsuburaya acted diligently to serve TIGA with the Summons and Counterclaims. Because Hong Kong is a signatory to the Hague Service Convention ("Hague Convention"), Tsuburaya attempted service of TIGA in accordance with the requirements of the Hague Convention, which is a process that often lasts several months. (*See* Declaration of Daniel C. Posner ("Posner Decl."), ¶¶ 4-7.) Tsuburaya commenced this process in October 2015, after counsel for plaintiff UM Corporation ("UMC") stated that he would not accept service on behalf of TIGA, as he had indicated he might do. (*Id.* at ¶¶ 2-3.)

1 On January 27, 2016, Tsuburaya received notice from the Chief Secretary for
2 Administration of the Government of The Hong Kong Special Administrative
3 Region, Administration Wing, that TIGA was served with the Summons and
4 Counterclaims on December 14, 2015. (Posner Decl., ¶ 7.) Tsuburaya filed a Proof
5 of Service of TIGA on January 28, 2016. (Dkt. 52.)

6 Because Tsuburaya acted diligently to serve TIGA pursuant to the Hague
7 Convention, and now has completed service on TIGA, Tsuburaya respectfully
8 submits that good cause exists to discharge the OSC as it relates to TIGA.¹

9 **2. The OSC Should be Discharged as to Sompote Because Tsuburaya is**
10 **Diligently Trying to Serve Sompote in Thailand.**

11 Second, Tsuburaya respectfully requests that the Court discharge the OSC as
12 to Sompote. In its Counterclaims, Tsuburaya alleges that Sompote fabricated a
13 claim to ownership of the copyrights in various Ultraman works, including by
14 falsifying a document purporting to show Tsuburaya's transfer of its rights in those
15 works to Sompote, and subsequently transferred or assigned some or all of his
16 purported rights in the Ultraman works to others, including to UMC and counter-
17 defendant Ultraman USA. (Dkt. 19 at 20-24.) Tsuburaya alleges that Sompote is a
18 resident in and citizen of Thailand. (*Id.* at 13.)

19 Because Sompote resides in a foreign country, the time-limits set forth in
20 Rule 4(m) do not apply to Tsuburaya's service of Sompote. *See* Fed. R. Civ. P.
21 4(m). Nevertheless, Tsuburaya has been diligently trying to serve Sompote in
22 Thailand, and requests additional time to do so.

23 Specifically, shortly after the Court issued the Summons on September 22,
24 2015, and once it was clear that Sompote would not be represented by the same

25
26 ¹ Counsel for plaintiff UMC and counter-defendant Golden Media Group, Inc.,
27 from the law firm Pillsbury Winthrop Shaw Pittman LLP, has stated that he will
28 represent TIGA in this action, now that TIGA has been served. (Posner Decl., ¶ 7.)

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1 counsel who represent plaintiff UMC, Tsuburaya began working with a process-
2 service company to assist in serving Sompote in Thailand. (Posner Decl., ¶¶ 4-5, 8-
3 9.) Because Thailand is not a signatory to the Hague Convention, service on
4 Sompote must be completed through personal service. To commence this process,
5 Tsuburaya had the Summons and Counterclaims translated into Thai. (*Id.*) Once
6 these translations were completed, the process server began working with an
7 affiliate in Thailand to attempt to personally serve Sompote at an address in
8 Thailand that Tsuburaya has reason to believe has been used by Sompote. (Posner
9 Decl., ¶¶ 5, 8; Declaration of Russell Ortiz (“Ortiz Decl.”), ¶¶ 2-4.) The process
10 server in Thailand made several unsuccessful attempts to serve Sompote at this
11 location between November 9 and December 3, 2015. (Ortiz Decl., ¶ 4 and Ex. A
12 (Affidavit of Due Diligence, signed by Rakesh Sharma).)

13 In light of the process server’s inability to locate Sompote at the original
14 address in Thailand, in late November 2015, Tsuburaya engaged the services of
15 Chris Reynolds, a highly-experienced private investigator, to assist with service of
16 Sompote. (Posner Decl., ¶ 9; Declaration of Chris Reynolds (“Reynolds Decl.”), ¶
17 4.) Mr. Reynolds (i) attempted to confirm Sompote’s address in Thailand through
18 Internet and other database searches; (ii) attempted to contact bloggers who have
19 written about Sompote; (iii) interviewed a journalist who had made contact with
20 Sompote and who provided an e-mail address for Sompote; (iv) sent a message to
21 that e-mail address (with no response); (v) worked with an international
22 investigation agency to attempt to locate a more current address for Sompote; and
23 (vi) obtained what appears to be a more current address for Sompote. (Reynolds
24 Decl., ¶¶ 4-9.) Mr. Reynolds is continuing to work with local Thai investigators to
25 attempt to locate and serve Mr. Sompote at this newly-obtained address. (*Id.* at ¶¶
26 10-11.)

27 In addition to the efforts noted above, Tsuburaya has sought the assistance of
28 counsel for UMC and counsel for counter-defendant Ultraman USA in attempting to

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1 locate Sompote. (Posner Decl., ¶ 10.) Tsuburaya was hopeful that UMC, whose
2 principal is believed to be Sompote's brother Perasit Saengduenchai, and Ultraman
3 USA, which has had business relations with Sompote, would be able to provide a
4 location for Sompote. Neither counsel for UMC nor counsel for Ultraman USA has
5 provided information regarding Sompote's location, other than that they both
6 believe he resides in Thailand. (*Id.*) Tsuburaya also has sent a copy of the
7 translated Summons and Counterclaims to the original address in Thailand where
8 Sompote was believed to reside or spend time, to help ensure that Sompote has
9 notice of this lawsuit and that Tsuburaya is attempting to locate him for service.
10 (Posner Decl., ¶ 11.)

11 In light of the efforts Tsuburaya has taken and continues to actively pursue to
12 serve Sompote, the difficulties of locating and serving Sompote in Thailand, and the
13 central role Sompote plays in this lawsuit,² Tsuburaya respectfully submits that good
14 cause exists to discharge the OSC as it relates to Sompote, and provide Tsuburaya
15 with additional time to effectuate service upon Sompote.
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18 ² In particular, the purported agreement in 1976 between Sompote and
19 Tsuburaya, through which Tsuburaya allegedly transferred broad rights in various
20 Ultraman works to Sompote, is the basis for all the opposing parties' claims that
21 they have valid rights to distribute and exploit Ultraman works. Thus, the validity
22 of the purported 1976 Agreement will be a critical disputed issue in this case.
23 Indeed, the other parties to the case have made clear that Sompote is central to their
24 positions as well. For example, in the parties' Joint Rule 26(f) report, counter-
25 defendant Ultraman USA stated that "it has a license from Mr. Sompote
26 Saengduenchai, in writing, to distribute certain figurines depicting the Ultraman
27 characters," and that it "may counterclaim against Mr. Sompote Saengduenchai if it
28 is determined that the representations made and money obtained were so obtained
without authority to grant the subject license." (Dkt. 32 at 4.) Similarly, UMC and
Golden Media Group stated that they may ask the Court to resolve in this lawsuit
that "Sompote Saengduenchai and Ultraman USA, Inc. have no rights whatsoever to
the Ultraman Works." (*Id.* at 13.)

1 DATED: February 2, 2016

Respectfully submitted,

2 QUINN EMANUEL URQUHART &
3 SULLIVAN, LLP

4
5 By /s/ Daniel C. Posner

6 Daniel C. Posner
7 Attorneys for TSUBURAYA
8 PRODUCTIONS CO. LTD.
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